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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LEE, MICHAEL	

ART UNIT	PAPER NUMBER
2622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/900,784	WASHINO ET AL.	
	Examiner	Art Unit	
	M. Lee	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *51-63 and 65-77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *51-63, 65-77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 65-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 65-77 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing ("[t]he Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process 'either [1] was tied to a particular apparatus or [2] operated to change materials to a 'different state or thing.'" See PTO Supp. Br. 4 (quoting *Flook,* 437 U.S. at 588 n.9). In *Diehr,* the Supreme Court confirmed that a process claim reciting an algorithm could state statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture. 12 450 U.S. at 184." *In re Comiskey,* 84 USPQ2d 1670 (Fed. Cir. 2007). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be "tied" to another statutory category, the structure of

another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 51-63 and 65-77 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. US RE37,342. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 51-63 and 65-77 are generic to all that is recited in claim 1-50 of the patent. That is claims 51-63 and 65-77 are anticipated by claim1-50 of the patent. For instance, claim 51 claims a video storage system comprising one or more inputs for receiving video program elements and supplemental

information related thereto, the supplemental information including: a) correlated edit-time-code information, and b) computer-readable scripting, casting, or staging information, and computer-readable media for simultaneously storing the video program source material at two different compression ratios. The claimed video program elements and supplemental information do not carry any patentable weight because they do not impart functionality to video storage system. The same goes to claims 52-59, 63, and 67-73. They are merely data structure stored in the storage. Hence, the only patentable elements are the one or more inputs and the computer-readable-medium. These elements are well covered by the digital video recorder as claimed in claims 1-50 of the patent. For instance, claim 1 of the patent claims a digital video recorder having two storage media for recording the same video program source material at different compression ratios which clearly meets the computer-readable media as claimed. The inherently included inputs at the storage media meet the one or more inputs as claimed. Claims 65-77 are process version of the apparatus claims which are covered by claims 10 and 11 of the patent. Although the patent does not further recite the limitations of claims 74-76, they are obvious variants of the patented apparatus claims. In other words, it would have been obvious to one of ordinary skill in the art to convey the patented apparatus claims to perform the method claims as claimed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 51-59, 63, 65-73, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by RD330020A.

Regarding claims 51-59 and 63, RD330020A discloses a dual quality recorder showing a higher quality recorder and a faster access recorder for recording video signals with different qualities or compression ratios, and each has an input for receiving input signals. These recorders clearly meet the computer-readable media as claimed. The claimed program elements and supplemental information as recited in claims 51-59 and 63 do not carry any patentable weight because they do not impart any functionality to the claimed invention. They are merely data structure being stored in the claimed media. The recorders in RD330020A are fully capable to perform such function. Thus, the use of RD330020A to store the claimed program elements and supplemental information is considered an intended use.

Regarding claims 65-73 and 77, see the corresponding rejections as set forth above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 60-62 and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over RD330020A.

Regarding claim 60, RD330020A does not disclose that the computer-readable media forms part of a camcorder as claimed. The Examiner takes Official Notice that using recorders in a video camera to record captured video signal is well known in the art because the recorders enable the captured video signal to be saved for later viewing. Hence, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use the recorders of RD330020A with a camcorder so that the captured video signal could recorded for later viewing.

Regarding claim 61, RD330020A does not disclose that the supplemental information is stored separately from the program elements as claimed. In any event, RD330020A does teach the edit list for editing the video which is inherently stored in the recorder. In order to distinguish the video signal from the edit list, it would have been obvious to one of ordinary skill in the art to record the video signal and the edit list at different location.

Regarding claim 62, RD330020A does not disclose that the video tape as claimed. Since the recorder in RD330020A can be any conventional recording medium or media, the selection of the well known video tape recorder using video tape to record the video signal would have been obvious.

Regarding claims 74-76, see the corresponding rejections as set forth above.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Lee whose telephone number 571-272-7349. The examiner can normally be reached on Monday through Thursday from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran, can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. Lee/
Primary Examiner
Art Unit 2622